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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,687	08/29/2003	Randolph S. Kohlman	2127B	9217

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Milliken & Company
P.O. Box 1926
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EXAMINER

PIERCE, JEREMY R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/651,687

Applicant(s)

KOHLMAN ET AL.

Examiner

Jeremy R. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 73-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 73-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on June 3, 2005 has been entered. Claims 73 and 75 have been amended. Claims 73-83 are currently pending. The amendment is sufficient to overcome the 35 USC 112 rejection set forth in section 2 of the last Office Action. Applicant's arguments are also sufficient to overcome the Nonstatutory Double Patenting rejection set forth in section 4 of the last Office Action.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 73-80 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Feitlowitz (U.S. Patent No. 3,809,573).

Feitlowitz discloses a method for imparting increased stiffness to woven and nonwoven fabrics (column 1, lines 15-27). Feitlowitz teaches thoroughly impregnating the fabric with a polymeric composition (column 2, lines 42-49). Although Feitlowitz does not explicitly teach the limitations of Kawabata stiffness values or Kawabata surface friction values, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. textile composition) and in the similar production steps (i.e. impregnating with a stiffening polymer) used to produce the fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed stiffness values would obviously have been provided by the process disclosed by Feitlowitz since the reference teaches adjusting the stiffness level (column 2, lines 50-69). Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. With regard to claim 79, the textile substrate is polyester (column 2, line 72). With regard to claim 80, Feitlowitz teaches the polymer thoroughly impregnates the fabric (column 2, lines 45-46), so the polymer would form anchoring structures.

5. Claims 73-79 and 81 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cross et al. (U.S. Patent No. 5,534,298).

Cross et al. disclose a stiff woven fabric with a polymeric coating (Abstract). Although Cross et al. do not explicitly teach the limitations of Kawabata stiffness values or Kawabata surface friction values, it is reasonable to presume that said limitations are

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inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. textile composition) and in the similar production steps (i.e. coating with a stiffening polymer) used to produce the fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed stiffness values would obviously have been provided by the process disclosed by Cross et al. since the reference teaches providing varying levels of stiffness (column 5, lines 27-39). Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. With regard to claims 79 and 81, the woven textile substrate may be 150 denier polyester (column 5, lines 7-26) and the coating is pressed into the fabric interstices (column 6, lines 4-6).

Claim Rejections - 35 USC § 103

6. Claims 81 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feitlowitz in view of Scholz et al. (U.S. Patent No. 6,159,877).

Feitlowitz does not disclose the denier size of the yarn or the fabric to be warp knitted. Scholz et al. teach a fabric with a controlled stiffness useful as an orthopedic support material (column 2, lines 45-60). Scholz et al. disclose manufacturing a woven or warp knitted fabric (column 7, line 57 –column 8, line 21) with a yarn denier of less than 500 (column 8, lines 35-36). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use the fabric disclosed by Scholz

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et al. in the invention of Feitlowitz in order to provide a fabric material that is useful as an orthopedic support, as taught by Scholz et al.

7. Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feitlowitz in view of Drelich et al. (U.S. Patent No. 3,889,024).

Feitlowitz discloses making a nonwoven fabric (column 1, line 45). However, Feitlowitz does not teach the length of the fibers. Drelich et al. teaches that nonwoven fabrics are conventionally made from fibers having a length between 0.5 and 2.5 inches (column 2, lines 36-40). Absent any specific teaching by Feitlowitz as to the length of the fibers, it would have been necessary, and therefore obvious to a person of ordinary skill in the art to use fibers with a length that is conventional in the art of nonwoven fabrics. Applicant's claimed fiber length range falls within what is conventional in the art for nonwoven fabrics.

Response to Arguments

8. Applicant's arguments filed June 3, 2005 have been fully considered but they are not persuasive.

9. Applicant argues that the burden of proof has not shifted to the Applicant with regards to the Examiner's assertion that the textile composition of Feitlowitz inherently possesses the claimed Kawabata stiffness values and surface friction values. Applicant argues that Feitlowitz uses generally dissimilar materials and clearly dissimilar processes in creating the textile composition than Applicant does. To support this argument, Applicant points out that Feitlowitz uses 100% polyester fabrics and that the

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resulting fabric in Feitlowitz is "very stiff." However, it must be pointed out that Applicant claims the textile substrate is polyester (claim 79). This is clearly a similar material. Also, Feitlowitz impregnates the fabrics with a stiffening polymer (column 1, lines 58-67). This is similar to Applicant's claim of a textile substrate impregnated with a polymer facing to provide for a certain degree of stiffness (claim 73). In light of this, Applicant's argument that the materials and process are dissimilar is unclear. The Examiner has found prior art that meets the claimed structural and material limitations. The Office is incapable of performing measurements on the material of the prior art to test its properties. Therefore, the burden has shifted to Applicant to prove otherwise. Similar reasoning applies with regard to the Cross et al. reference.

10. Applicant argues that Cross et al. uses a process that does not result in the penetration of the compound to the opposite side of the fabric. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., penetration of the compound to the other side of the fabric) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. Applicant argues that they are concerned with the smoothness of the composite surface, a consideration that appears to be of little or no importance to Cross et al. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,

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smoothness of the composite surface) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Applicant argues that Scholz et al. do not cure the shortcomings of Feitlowitz. However, as addressed above, the Examiner does not believe Feitlowitz possesses the shortcomings argued by Applicant.

13. In response to applicant's argument that there is no suggestion to combine the Scholz et al. and Feitlowitz references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would use the fabric type and denier size disclosed by Scholz et al. in order to provide a fabric that is suitable as an orthopedic support.

14. Applicant argues that Drelich et al. do not cure the shortcomings of Feitlowitz. However, as addressed above, the Examiner does not believe Feitlowitz possesses the shortcomings argued by Applicant.

Conclusion

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15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on normal business hours, but works flextime hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JRP

Jeremy R. Pierce

August 8, 2005

Elizabeth M. Cole
ELIZABETH M. COLE
PRIMARY EXAMINER